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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,567	10/23/2003	Tadashi Ishida	029430-554	5977
21839	7590	01/06/2005	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			CAMERON, ERMA C	
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ALEXANDRIA, VA 22313-1404			PAPER NUMBER	

1762

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,567

Applicant(s)

ISHIDA ET AL.

Examiner

Erma Cameron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 18: there is no antecedent basis for (A), (B) and (C); it appears that claim 18 should be dependent on claim 17.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14, 16-17 and 23-25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 802245.

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'245 teaches coating an ink-jet receiving layer on a base layer. The ink layer composition comprises pore-containing (i.e. void-containing) cationic fine particles of a crosslinked resin and a binder. The cationic fine particles are polymerized from (meth)acrylic esters having an amino group, (meth)acrylamides having an amino group, or their quarternized counterparts. The composition is applied by cast coating or a bar coater and then supercalendared (i.e. mirror roll) (3:31-53, 13:36-48, 16:11-32, see Examples). The ink layer composition may contain white inorganic pigments, but this is not required. '245 does not describe the resin as thermoplastic, but because it is formed from the same materials as applicant's claimed organic component, the resin particles are inherently thermoplastic.

5. Claims 14, 16 and 23-25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 09-300810.

'810 teaches cast-coating a (meth)acrylic/alkylamino polymer onto a support for ink-jet recording paper, followed by pressing with a heated mirror-finished drum (see Abstracts).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 802245.

‘245 is applied here for the reasons given above.

‘245 does not disclose the Tg or Mw of the resin particles, but it would have been obvious to one of ordinary skill in the art to have optimized these known parameters through no more than routine experimentation depending on the properties of the ink layer that are desired.

‘245 does not disclose that the calendaring process is at a lower T than the Tg of the resin particles, but it would have been obvious to one of ordinary skill in the art to have not calendared the layer above the Tg of the particles, so as to not alter the physical state of the particles.

The wt% composition of the resin fine particles appears to overlap that claimed by applicant.

‘245 discloses that the water absorption capacity is 10-25 times, but does not disclose the absorption in the same terms as applicant. Because the resin particles of ‘245 are very similar in composition to the particles claimed by applicant, it would appear that the absorption capacities would be similar or overlapping.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09-300810.

‘810 is applied here for the reasons given above.

‘810 teaches that the Tg of the polymer is >40 degrees C, which overlaps with applicant's claimed Tg range.

Priority

9. The priority statement should be updated.

Conclusion


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ERMA CAMERON
PRIMARY EXAMINER

Erma Cameron
Primary Examiner
Art Unit 1762

January 1, 2005